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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,099	02/11/2004	Yasushi Sano	Q79674	1568
23373	7590	10/18/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			CHEA, THORL	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,099

Applicant(s)

SANO ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/186,392.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3, 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to provide support for the language "one or more photographic reagents that require heat-melting prior to use, and "when preparing two or more photographic reagents, repeating step (i) to (iii) in claim 1, and "when preparing two or more photographic reagents, repeating step (i) to (iii) in claim 22. The step of measuring the amount of photographic reagent transferred to the measuring tank in claims 1, 22 step (ii). The language "one or more photographic reagents comprise silver halide emulsion" in claim 18; the photographic reagents contains a different additive in claim 20, and "said additive is a sensitizing dye" in claim 21.

The specification as originally filed as a whole is directed to the heating the silver halide emulsion, while the claiming the one or more photographic reagent or more photographic reagent extend beyond the scope of the heating the prepared liquid of a silver halide emulsion for used in a heat developable material. The step of measuring the amount of the photographic reagent claimed in step (ii) and pointed out to page 10 of the specification, the photographic reagent

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transferred into the measuring tank 90 is measure with load cell. This transfer is related to the silver halide emulsion. Therefore, it would not provide support to the regent within the meaning claimed in the present invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3, 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of protection sought for the “photographic reagent”, additional photographic reagent, different additive, “one or more photographic reagent comprise a silver halide emulsion” in claims 1, 18, 22 is indefinite with respect to the scope of “photographic reagent”. The specification discloses only the use of claimed method in the preparation of liquid of a silver halide emulsion. However, the term “photographic reagent” encompasses the scope of any reagent useful in a formation of a photographic material, which extends beyond the scope of silver halide. In the absence of providing the metes and bound thereof such term “is indefinite”. See the definition of “reagent” in the Webster’s Ninth New Collegiate Dictionary as a substance used (as in detecting or measuring a component, in a preparation of product, or in development photographs) because of its chemical or biological activity. Therefore, the term “photographic agent” is indefinite, and so the scope of the claimed invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1, 19-21 is rejected under in the alternative, under 35 U.S.C. 103(a) as obvious over Bagchi et al (US Patent No. 5,385,812).

Bagchi et al discloses a method for preparing a microprecipitated photographic reagent using similar process as claimed. See Fig. 3, sheet 3 of 10 and the description thereof in column 5, lines 50-68 and column 6, lines 1-48 wherein the photographic reagent was transferred through a pipe (63,67) without being heated to the tank 70 with water jacket 71; the pumping rate of pump 60 is adjust to a desired value prior to the run to produce the melt with predetermined photographic reagent concentration; the pump 64 is adjusted to the desired value prior to the run to produce a melt of the desired gelatin concentration. See also the flow meter (62, 68). This method is used for every photographic reagent such as dye, surfactant, stabilizer and absorbing compound in columns 8-9, and column 17, claim 2. The amount of the melt in tank 70 is therefore measured through the flow meter, and therefore the amount has been measured and known. Bagchi et al may not clearly state that the "measuring tank" presented in the claimed invention, but the tank taught in Bagchi et al and presented claimed invention serve similar function. Accordingly, the invention as claimed is either anticipated or found obvious to the worker of ordinary skill in the art.

7. Claim 3, 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bagchi et al as applied to claim1 above, and further in view of Bosvot et al (US Patent No. 5,264,024). Bostvot discloses the process of melting silver halide emulsion. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the process taught in

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Bagchi et al to melt the silver halide emulsion taught in Bosvot et al with a reasonable expectation of achieving a useful coating composition, and thereby provide a process as claimed.

Response to Arguments

8. Applicant's arguments filed April 8, 2005 have been fully considered but they are not persuasive. The prior art of record may not disclose the step of transferring a photothermographic reagent to a measuring tank without being heated and after measuring, heat-melting the measuring such as being presented in the argument. However, this modification would have been obvious to the worker of ordinary skill in the art. First, the photographic reagent taught in the jackets and not via the piping. Second, the photographic reagent and the gelatin and water are brought to the tank with a measured amount through line 16, 48, and 65 without being heated. Using the piping or the other means to bring the photographic reagent in the jacket would be obvious to the worker of ordinary skill in the art. Accordingly, it is believed that the claimed process would have at least found prima facie obvious over the teaching of Bagchi et al.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tch. *tch*
October 15, 2005

Thorl Chea
Thorl Chea
Primary Examiner
Art Unit 1752